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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,976	03/31/2004	Kazuo Banju	P/3541-56	8684
2352	7590	08/07/2006	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,976

Applicant(s)

BANJU, KAZUO

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/31/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the a) “independent rotary portion” (claim 3) and b) the “plurality of rotating mechanisms similar to the first-mentioned rotation mechanism” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 3, it would appear that the “engagement means” is referring to a different element than the “limiting means”, as claimed in claim 2, yet the specification only mentions “engagement means” as another term for the “limiting means” (page 11, lines 24-25). Therefore, the specification fails to set forth what is encompassed by the term “engagement means” in claim 3.

Further in claim 3, the term “independent rotary portion” is used with respect to the rotation mechanism, yet the specification fails to define such an element. It is unclear as to what this is referring.

As to claim 5, the specification describes a combination including ONE rotation mechanism in each embodiment of the combination and thus fails to disclose a plurality of such rotation mechanisms or how they would be combined in the disclosed embodiments.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 5, the term “similar to” when describing other rotation mechanisms creates confusion as to what encompasses a structure that is “similar to” the one disclosed. Besides not having a definite meaning, the term “similar to” could be interpreted differently from one person to another.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (U.S. Pat. 5,689,365).

Referring mainly to Figure 7, Takahashi discloses a stereoscopic optical unit provided with a pair of objectives (15) and optical devices corresponding to the respective objectives (20 or 14), a stereoscopic camera (18) connected to the optical unit, a support unit (2) which supports either or both the optical unit and camera (Fig.7), a rotation mechanism incorporated in the support unit and having a rotary shaft (16,17) substantially parallel to an optical axis of the objectives (Fig.7), the rotation mechanism supporting the optical unit and/or camera such that

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they can rotate about the axis of the rotary shaft (col.7, lines 42-46). As to claim 2, as is inherent with any rotation mechanism, there will be at least some friction between components. As to claim 3, there is a joint portion (proximal end of insertion portion 2, near 4) which rotatably (mechanically and disengageably) engages operation unit (3) (Fig.7). Although it is not clear what the term "independent rotary portion" is referring, the rotation mechanism (16,17) rotates even when operation unit (3) is engaged with the joint portion (proximal end of insertion portion 2). As to claim 4, the rotary shaft is substantially coaxial with the optical unit as shown in Figure 7. As to claim 6, the optical unit forms a stereoscopic endoscope.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

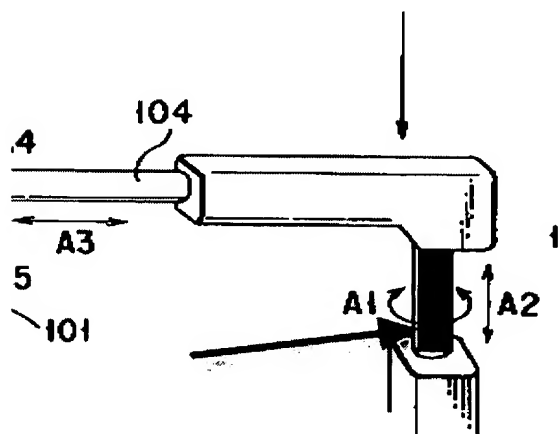
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno et al. (U.S. Pat. 6,120,433) in view of Takahashi (U.S. Pat. 5,776,049).

Referring mainly to Figure 9, and regarding claims 1 and 6, Mizuno discloses stereoscopic endoscope (105, col.19, lines 8-10), a support unit (robot 104) which supports the endoscope (Fig.9), and a rotation mechanism incorporated in the support unit and including a rotary shaft (highlight in the picture below) which is substantially parallel to an optical axis of

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the objectives (note in Figure 9 that rotary joints near the endoscope that allow rotation around A4 and A5 will allow the endoscope



retain a vertical (with respect to gravity) orientation, the same as the rotary shaft), the rotation mechanism supporting the instrument such that the instrument can rotate about an axis of the rotary shaft (note A1). Mizuno et al. fails to disclose the particulars of the stereoscopic endoscope. Takahashi shows just one example of what was known in the art at the time of the invention. Takahashi teaches a stereoscopic endoscope including pair of objectives (3a,3b), optical devices (4a,4b) corresponding to the objectives, and a stereoscopic camera (2a,2b). Given that Mizuno et al. fails to disclose the particulars of the stereoscopic endoscope, it would have been obvious to one of ordinary skill in the art at the time of the invention to have “filled in the gaps” from what is known to the ordinary skilled artisan. Thus, it would have been obvious to have used a known prior art structure, such a Takahashi, as the stereoscopic endoscope of Mizuno et al.

As to claim 2, there would inherently be frictional resistance limiting rotation of the rotary shaft. As to claim 3, note other joints (at 118 for instance) with other structure engaged

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therewith (note col.9, lines 30-34). Inherently, the rotary shaft would rotate even when other joints are engaged with the engagement means. As to claim 5, although unclear, note other joints that allow rotation (e.g., 118).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schara et al. (US 2005/0256371)

Ueda et al. (US 2004/0138524)

Mizuno et al. (U.S. Pat. 6,569,084)

Kaji (U.S. Pat. 6,142,931)

Wang et al. (U.S. Pat. 6,102,850)

Shimmura et al. (U.S. Pat. 6,514,239)

Wang et al. (U.S. Pat. 5,907,664)

Otsuka et al. (US 2004/0172012)

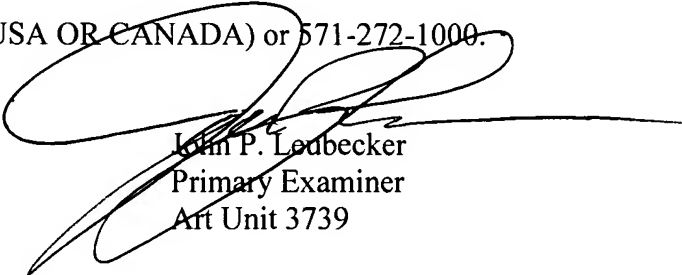
Heller (U.S. Pat. 5,173,802)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Leubecker
Primary Examiner
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jpl